

### REMARKS

In view of the following remarks, reconsideration and allowance are respectfully requested.

Claims 1-9, 13-16, 18, and 20 are pending at the time of this action, with Claims 1, 18, and 20 being independent. Claims 10-12, 17, 19, and 21 were previously cancelled. No claims are currently being amended, and no new matter is being added.

Claims 1-9, 13-16, 18, and 20 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Thurlow et al., in view of Flanagan (U.S. Patent No. 6,057,841), referred to as Thurlow; "Java in a Nutshell," referred to as Flanagan).

#### 35 U.S.C. 103(a) - Claims 1-9, 13-16, 18, and 20

Regarding the rejection of claim 1-9, 13-16, 18, and 20 under 35 U.S.C. 103(a) as allegedly being unpatentable over Thurlow in view of Flanagan, Applicant respectfully submits that neither Thurlow nor Flanagan, nor any proper combination of the two, discloses or properly suggests all of the limitations of independent claims 1, 18, and 20. This rejection fails to establish a *prima facie* case of obviousness. In particular, obviousness has not been met at least because (1) the rejection fails to consider portions of Thurlow that "teach away" from the proposed combination and (MPEP 2141.02), and because (2) the proposed combination would destroy the functioning of the reference, or make it unsatisfactory for its intended purpose (MPEP 2143.01).

Claim 1 recites a computer-implemented method that displays a graphical user interface (GUI) on a display device of a computer, where the GUI includes a representation of a condition and a representation of an action of a user-defined rule to process textual information. The condition includes an attribute name, an operator, and an attribute value, and the action includes an action name and an action value. The method also includes receiving, via the GUI, user input that indicates the user-defined rule is to be used to create a rule template and, in response, creating a rule template. The rule template has a condition that is based upon the condition of the user-defined rule and has an action that is based upon the action of the user-defined rule. The

condition of the rule template includes, among other elements, an attribute-value placeholder that is associated with the attribute value from the corresponding condition of the user-defined rule. The action of the rule template further includes, among other elements, an action-value placeholder that is associated with the action value from the corresponding action of the user-defined rule. The method also includes receiving a second user input that indicates a value to be used in place of the attribute-value placeholder and a value to be used in place of the action-value placeholder, and, in response, creating and storing a second user-defined rule to process textual information. The second user-defined rule is based on the rule template and includes the value to be used in place of the attribute-value placeholder and a value to be used in place of the action-value placeholder. The method further recites using the second user-defined rule to process incoming textual information received from a customer system and triggering the action of the second user-defined rule when the incoming textual information satisfies the condition of the second user-defined rule.

The Office Action asserts that Thurlow discloses all of the features of claim 1 except "Thurlow does not teach the user inputs indicating the user defined rule is to be used to create the template" (Office Action: page 4: paragraph 2). However, even without submitting to the propriety of the Examiner's characterization of a feature of the claim, Applicant submits that Thurlow does not disclose or properly suggest other features of claim 1. For example, Thurlow fails to disclose the many features of "creating, in response to the received user input, a rule template having a condition that is based upon the condition of the user-defined rule," as recited in independent claim 1.

Instead, Thurlow discloses techniques for processing electronic messages by applying a rule representing a combination of additions, actions, or exceptions (Thurlow: Abstract). In particular, Thurlow discloses a method and system for creating and editing rules for electronic messages, such as for "OUTLOOK 97" by Microsoft Corporation of Redmond, Washington (Col. 3: lines 23-31). Thurlow discloses a "Rules Wizard" that "divides the process into discrete steps and provides a user-friendly interface for creating and editing rules," where "at each step the user selects the parameters that constitute the rule." (Thurlow: Col. 9, lines 18-35). Fig. 5

shows a state diagram for the various discrete, sequential steps used in the Rules Wizard to create a new rule or edit or rename an existing rule (Thurlow: Col. 10:48-63). These discrete, sequential steps are shown in the example diagrams of Figs. 6a, 6b, 6c, 7a, 7b, 7c, 8a, 8b, 8c, 9a, and 9b. However, none of these discrete, sequential steps in Thurlow show the claim features of "creating, in response to the received user input, a rule template having a condition that is based upon the condition of the user-defined rule," as recited in independent claim 1. These claim features are absent from Thurlow. Claim 1 is patentable over the combination for at least this reason alone.

Pages 7-8 of Office Action pointed to sections of Thurlow, including Cols. 2:38-46 and 10:26-34, for allegedly disclosing this feature of claim 1. Thurlow discloses the following in the cited sections.

In another aspect, the present invention provides a method for constructing a rule for processing electronic messages. The method includes displaying a list of rule templates and receiving an input signal indicating the selection of one of the rule templates. A condition and action associated with the selected template are then displayed. The current state of the rule is displayed in a natural language format. The rule is then stored for subsequent processing of electronic messages. Thurlow, 2:38-46.

The machine-readable format for each natural language action clause is of the form:

[ACTION] [PARAMETER 1] {PARAMETER 2} [...]  
where ACTION is an identifier for the selected action and PARAMETER N is a parameter associated with the action. For example, the PARAMETER may be the identifier of the folder into which matching messages are to be filed. Thurlow, 10:26-34.

Hence, Thurlow does not teach or properly suggest each and every feature of claim 1. For example, Thurlow does not disclose a user "creating ...a rule template," as in claim 1. Instead, Thurlow discloses that a user views a displayed list of templates and selects one of the listed templates, as shown above (Thurlow: 2:38-46). The rule templates are pre-existing and pre-created before the user views the displayed list. Hence, Thurlow fails to disclose a method that includes "creating, in response to the received user input, a rule template having a

condition that is based upon the condition of the user-defined rule." Claim 1 is patentable over the suggested combination for this reason alone.

Furthermore, Thurlow fails to disclose **"creating, in response to the received user input, a rule template having a condition that is based upon the condition of the user-defined rule and an action that is based upon the action of the user-defined rule,"** as recited in claim 1. So, not only does Thurlow fails to disclose a user creating a rule template, Thurlow further fails to disclose doing so based on selecting an existing rule. There is no teaching of a rule template being created based upon an existing rule in Thurlow.

Instead, Thurlow discloses that a rule is created based upon selecting a displayed list of pre-existing rule templates (Thurlow: 2:38-46). "The rule is then stored for subsequent processing of electronic messages" (Thurlow, 2:44-46). **Hence, Thurlow discloses that the rules themselves can be created from pre-existing templates and then stored for later use. However, Thurlow does not disclose that the templates themselves are created based on pre-existing rules and then subsequently stored for later use.** This is another distinction that Thurlow fails to teach or suggest in the combination, for which claim 1 should be allowed.

For at least the reasons above, the Office Action attempts to use Flanagan to remedy the many deficiencies of Thurlow in the suggested combination. Flanagan is a reference book for the JAVA programming language. One skilled in the relevant art would know that JAVA includes an object-oriented programming language from and maintained by Sun Microsystems of Santa Clara, California. The Office Action refers to two pages of the JAVA handbook of Flanagan to allege that "Flanagan teaches the user input indicating the user defined rule is to be used to create a rule template" (Office Action: page 4, paragraph 3). The Office Action points to pages 66-67 of Flanagan and alleges that "[I]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Thurlow by identifying components of a class of object oriented programming as taught by Flanagan to have the user inputs indicating the user defined rule is to be used to create a rule template" (Office Action: pages 5-6).

However, the rejection to claim 1 for obviousness cannot be sustained for several

reasons. First, the suggested combination does not teach or properly suggest each and every feature of the claim. For example, many deficiencies were pointed out above in the teachings of Thurlow, and Flanagan does not remedy those deficiencies. For example, Thurlow teaches using a pre-existing rule template to create a rule (Thurlow: 2:38-46). However, **Thurlow and Flanagan do not teach or properly suggest using a condition of a pre-existing rule to create a rule template.** Both references are silent on that claim feature and the other aforementioned claim features. Hence, claim 1 is patentable over the suggested combination of Thurlow and Flanagan for at least these reasons alone.

Second, the rejection fails to consider portions of Thurlow that "teach away" from the proposed combination and (MPEP 2141.02). For example, the "Rules Wizard" of Thurlow is used so that a rule can be created in a user-friendly manner, so that a user does not have to use or know about the complexities of employing a programming language to create the rule (Thurlow: 1:49-54; 9:24-36). In particular, Thurlow teaches the following in regards to not using programming languages.

In the prior art, this type of function was provided by a programming-type scripting language that was used to specify events and to designate actions for events that meet those conditions. **Because it relies on a cryptic, programming-type language, this approach is not very user-friendly.** (Thurlow: 1:48-54, emphasis added)

The present invention provides an improved system and method for creating and editing rules for processing electronic messages, such as e-mail, meeting requests, and task requests. Generally described, the invention is embodied in a "Rules Wizard," which divides the process into discrete steps and provides a **user-friendly interface** for creating and editing rules. At each step, the user selects the parameters that constitute the rule. As parameters are selected, **the rule is composed and presented to the user in the form of a natural language (e.g., English) sentence, instead of in a programming-type language.** If the rule requires more information from the user, the user is prompted by highlighted text within the **natural language sentence** itself. The user can then select the highlighted text and define the variable. The rule creating process is further simplified by the use of templates and context-specific rules. Once created, the rules may be executed by the client application or the mail server. (Thurlow: 9:24-41, emphasis added).

Hence, Thurlow provides clear teachings against forming a combination with a “programming-type language,” including the programming language of JAVA as referenced in Flanagan. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Therefore, at least because the combination itself is improper, the rejection to claim 1 under 35 U.S.C. 103 should be withdrawn for at least this reason.

Third, if Thurlow was combined with the known art of programming languages, then the proposed combination would destroy the functioning of the reference, or make it unsatisfactory for its intended purpose (MPEP 2143.01). This is an additional reason for withdrawing the rejection to claim 1.

Therefore, for at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 and its dependent claims. Independent claims 18 and 20, although different in scope from claim 1 and each other, recite subject matter similar to that in claim 1 discussed above. In accordance with the above, Applicant submits that Thurlow and Flanagan do not render independent claims 1, 18 and 20 obvious, so that claims 1, 18 and 20 and their dependents are allowable for at least the above reasons.

#### In Conclusion

Applicant submits that all pending claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

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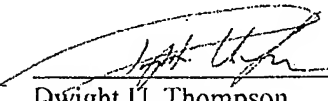
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Respectfully submitted.

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